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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/062,552	04/20/1998	YOSHINOBU SHIRAIWA	35.G2135	3178

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NEW YORK, NY 10112

EXAMINER	
WALLERSON, MARK E	

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/062,552	Shiraiwa
Examiner	**Art Unit**
Mark Wallerson	2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jun 23, 2003* .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *80-93* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *80-93* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *30, 32*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on **6/23/2003.**

2. This application has been reconsidered. Claims 80-93 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 80, 81, 82, 83, 84, 85, 86, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (U. S. 6,111,659) in view of Timmermans (U. S. 5,862,297).

With respect to claims 80, 81, 86, and 87, Murata discloses an accessing unit (88) that accesses a recording medium (memory card), the recording medium having a plurality of reproducible images (image data files) and a reproduction instruction file (print job command file) containing plural file names specifying images to be reproduced (figure 6), the instruction file separate from the plural images (column 6, lines 40-46); means for reading the reproduction instruction file (column 8, lines 52-60); means for controlling reproduction of the images by

reading the images specified by the reproduction instruction file (column 8, line 52 to column 9, line 1), and printing a reproducible image specified by the instruction file if the reproducible image is recorded in the recording medium (column 8, line 52 to column 9, line 1).

Murata differs from claims 80, 86, and 87 in that he does not clearly disclose that reproduction is not performed for a particular image if that image is not recorded on the recording medium. However, it would be clearly obvious to one of ordinary skill in the art that if an image is not recorded on a recording medium (a disk), it cannot be read and printed.

Murata also differs from claims 80, 86, and 87 in that he does not clearly disclose that when reproduction is not performed for the particular image, identification information of the particular image is stored in a memory.

Timmermans discloses a photographic printing system wherein if picture parameter data stored on a disk is incorrect, information about the desired changes of the picture parameter data relative to the set of picture parameter data recorded on the record carrier is stored for the record carrier specified by means of the record carrier identification code (column 10, lines 36-56), wherein the format of the picture parameter data included a DID in which the unique record carrier identification code is stored (column 10, line 57 to column 11, line 23). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata so that when reproduction is not performed for the particular image, identification information relating to the particular image is stored in a memory. It would have

been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata by the teaching of Timmermans in order to improve the image processing.

With regard to claims 83, 84, and 85, Murata discloses means for displaying the file name of the image to be reproduced and the image to be reproduced (column 7, line 60 to column 8, line 51).

With respect to claim 82, Timmermans discloses displaying information relating to the image not reproduced (column 10, lines 36-56).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 88-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata in view of Haneda (U. S. 6,243,171).

With respect to claims 88, 90, 92 and 93, Murata discloses a recording control apparatus for controlling recording of images in a recording medium (memory card), the apparatus including an accessing unit (88) that accesses a recording medium for storing a plurality of reproducible images and a reproduction instruction file (column 6, lines 40-46) containing instruction information including plural file names (figure 6) specifying image data to be reproduced (print control data) (column 6, lines 40-46), comprising an indication section for indicating deletion of at

least one of the images (column 3, lines 36-44), and a control section for controlling deletion of the instruction information in the instruction file corresponding to the indicated image (column 3, lines 36-44).

Murata differs from claims 88, 92, and 93 in that he does not clearly disclose that the accessing unit accesses the recording medium (accessed to specify an image to be reproduced) in accordance with a manual operation.

Haneda discloses a laboratory system wherein image data and order data recorded on a recording medium can be manually accessed by an operator in the laboratory (column 5, lines 30-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata wherein the accessing unit accesses the recording medium in accordance with a manual operation. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Murata by the teaching of Haneda in order to obtain more user control.

With regard to claim 89, Murata discloses the recording medium is a detachable memory (column 3, lines 45-50).

With respect to claim 91, Murata discloses a display unit to display the image to be deleted (figure 16).

Response to Arguments

7. Applicant's arguments filed 6/23/2003 have been fully considered but they are not persuasive.

With respect to claims 80-87, Applicant submits that *Timmermans* does not disclose that when reproduction is not performed for the particular image identification information of the particular image is stored in a memory. The Examiner respectfully disagrees.

Timmermans discloses a picture recording system wherein when incorrect picture parameter information is recorded on a record carrier and information about the desired changes of the picture parameter data relative to the set of picture parameter data recorded on the record carrier is stored for the record carrier specified by means of the record carrier identification code (column 10, lines 36-56), wherein the format of the picture parameter data included a DID in which the unique record carrier identification code is stored (column 10, line 57 to column 11, line 23). Figure 9 also depicts a format (120) in which adaptations of the set of picture parameter data is stored in the memory, wherein the format includes set identification numbers for which information about the picture parameter data has been stored.

With respect to claims 88-93, Applicant submits that in *Haneda*, the user's recording medium from which order data may be read is not the same as the recording medium from which the plurality of reproducible images and a reproduction instruction file are stored. Again the Examiner respectfully disagrees.

Figure 14 of *Haneda* clearly shows the user's disk which includes the reproducible images (image file) (figure 16) and a reproduction instruction file (order file) (figure 18).

Conclusion

8. All claims are rejected.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

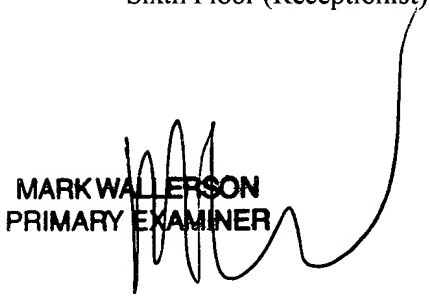
or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington. VA.
Sixth Floor (Receptionist)



Mark Wallerson